

REMARKS/ARGUMENTS

The above-indicated Office Action has been carefully considered. However, applicants believe that a truly patentable invention is presented. Accordingly, reconsideration of the claims as now amended is respectfully requested.

Claim 1 has been amended; claims 2-20 remain as originally filed.

In paragraph 2 of the above-indicated Office Action, claims 1-2 and 8-9 are rejected under 35 USC §102(e) as allegedly being anticipated by Hansen U.S. Pat. No. 6,742,799, filed January 6, 2003 and issued June 1, 2004. This rejection is respectfully traversed.

Hansen '799 discloses—

A hitch adapter for connecting at least one accessory, such as a bicycle carrier, a motorcycle carrier, a platform for hauling cargo, a lift platform, a storage compartment, a truck bed extenders [sic] or a roof rack extender, to a receiver hitch. (Abstract of Hansen '799.)

According to the specification and drawings of Hansen '799, the "hitch adapter" there disclosed and claimed incorporates a centrally located "linkage piece 30," an associated "engaging tube 32" and an associated "hitch extender 38." Interconnectable with opposite side portions of the "linkage piece 30" are end opposed, outwardly extending side "arms" 40 and 50. At the outer end of each side "arm" 40 and 50 is both "an accessory connection receiver" 48 and 58 plus a terminal, angularly, perpendicularly projecting (relative to each "arm" 40 and 50) "frame adapter bracket" 46 and 56 (see, for example, Fig. 4 of Hansen '799 and the detailed description of Hansen '799 at col. 4, line 9 through col. 5, line 11).

The language (or terminology) employed in claim 1 of Hansen '799 (the sole claim in Hansen '799) is somewhat different from that employed in the Hansen '799 specification. The claim's preamble relates to "a receiver hitch" to which the Hansen "hitch adapter" is "connecting." In the body of claim 1 of Hansen '799, the term "adapter body" includes the "arms" 40 and 50 plus the "engaging tube 32." Each "arm" has both "an adapter bracket" that is intended to correspond with "frame adapter bracket" 46 and 56 and also "an accessory connection receiver" that is intended to correspond with each "accessory connection receiver" 48 and 58.

Applicants' "towing hitch extension," as disclosed in the specification and drawings of their patent application, and as set forth in rejected independent claim 1 (upon which rejected claims 2, 8 and 9 are each directly or indirectly dependent) employs:

"a tow bar having front and rear ends,"

"a front coupling means for releasable coupling engagement with" a "towing hitch,"

"a transversely extending, horizontally oriented, elongated cross bar extending across and medially adjoining said rear end," and

"a rearwardly opening towing hitch socket mounted at said rear end and vertically offset relative to said tow bar and said cross bar."

Applicants' "towing hitch extension" includes a "rearwardly opening towing hitch socket mounted at the rear end of the tow bar that is vertically offset relative to the tow bar and to the cross bar. However, applicants' towing hitch extension" is clearly and fairly not--

"for connecting at least one accessory, such as a bicycle carrier, a motorcycle carrier, a platform for hauling cargo, a lift platform, a storage compartment, a truck bed extenders [sic] or a roof rack extender, to a receiver hitch" (from the above reproduced Hansen '799 Abstract)--

as in Hansen '799. For such connection purposes, the Hansen '799 device requires "a linkage piece 30" associated with "arm" pieces 40 and 50 (as set forth in the Hansen '799 specification, as explained above) that are each associated with both an "adapter bracket" and also an "accessory connection receiver" (as set forth in the Hansen '799 claim 1). The Hansen '799 "adapter bracket" and "accessory connection receiver" are both absent from the applicants' "towing hitch extension." As a result, applicants' towing hitch extension is incapable of being used "for connecting" as stated in Hansen '799 for that hitch adapter.

Applicants' towing hitch extension, as stated in the preamble of applicants' claim 1, functions "to protect the rear bumper of a towing vehicle" Because applicant's towing hitch extension completely lacks the "adapter bracket" and the "accessory connection receiver" that are present in the Hansen '799 hitch adapter, applicants' towing hitch has a structure different from that of the Hansen '799 hitch adapter and cannot function comparably. Applicant's hitch adapter is distinctly different from, not suggested by, and not equivalent to the Hansen '799 hitch adapter.

The differences between Hansen '799 and applicants' invention are such that neither can be used in place of the other to obtain the functions or performance achieved.

It is improper for purposes of alleging anticipation under 35 USC §102 for the Examiner to attempt a redesign of a structure such as shown and required by Hansen '799 and to eliminate from that structure required components thereof for purposes of making an allegation that Hansen '799 anticipates applicants' claim 1 structure. Nothing in Hansen '799 justifies or supports such a structural redesign. Under 35 USC §102, it is improper for the Examiner to use hindsight and read back into the prior art the teachings of applicants' invention.

As shown in the text of 35 USC §102(e), which is reproduced in the above-noted Office Action, §102(e) requires that for an invention to be anticipated by a "printed publication," such as Hansen '799, the invention must be "patented or described" in that "publication." Applicants' towing hitch extension is not "patented or described" in Hansen '799. Anticipation is determined by comparison of the reference with the claims.

To anticipate, every element of the claimed invention must be shown in a single piece of prior art. To anticipate, a piece of prior art must not merely approximate or be similar to the patent claim in question. There must be an identity of invention between the prior art and the claim in question. There is nothing in Hansen '799 that discloses or suggests the combination of applicants' invention. Accordingly, applicants' invention as set forth in their claim 1 is clearly and fairly not anticipated by Hansen '799 under 35 USC §102(e).

Indeed, Hansen '799 is so far removed from applicants' invention that Hansen '799 does not teach or suggest applicants' invention under 35 USC §103. In fact, the differences between Hansen '799 and applicants' invention are such that Hansen '799 actually leads one skilled in the art away from applicants' invention.

Applicants accordingly respectfully request that the rejection under 35 USC §102(e) of claims 1,2, 8 and 9 be reconsidered and withdrawn.

The Examiner's statement in paragraph 3 of the above-noted Office Action that claims 12-20 are allowed is acknowledged with appreciation.

In view of the Examiner's objection to claims 3-7, 10 and 11 as being dependent upon a rejected base claim, the base claim (claim 1) is amended herein to include language from allowed

independent claim 12. As amended, claim 12 and claims 3-7, 10 and 11 are believed to be in allowable form.

In view of the preceding claim amendment and the foregoing remarks, this application is believed to be in condition for allowance. Early and favorable consideration is respectfully requested. Please charge any fees due in connection with this response to our Deposit Account No. 15-0508/300125-1.

Respectfully submitted,


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By 
Michael A. Hierl, Reg. No. 29,807

OLSON & HIERL, LTD.
20 North Wacker Drive, 36th Floor
Chicago, Illinois 60606
(312) 580-1180
Attorneys for Applicants

CERTIFICATE OF MAILING

I hereby certify that this paper and the accompanying Declaration are being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 20, 2004.


Michael A. Hierl